## REMARKS

By this amendment, Claim 1 and 36 has been amended. No claims have been added, or cancelled. Hence, Claims 1-70 are pending in the application.

## SUMMARY OF THE REJECTIONS

Claims 1-15, 17-27, 31-50, 52-62, and 66-70 were rejected under 35 U.S.C. § 103(a) as allegedly being unpatentable over U.S. Patent No. 6,094,680 issued to Hokanson et al. ("*Hokanson*") in view of U.S. Patent Number 6,163,878 issued to Kohl et al. ("*Kohl*"). Claims 16, 28-30, 51, 63-65 were rejected under 35 U.S.C. § 103(a) as allegedly being unpatentable over *Hokanson* in view *Kohl* in view of U.S. Patent Number 6,330,575 issued to Moore et al. ("*Moore*").

## INTERVIEW SUMMARY

The Applicant thanks the Examiner for the Interview conducted on February 10, 2005. The interview was between Examiner Le, her Primary Examiner, and the Applicant's Attorney, Christopher J. Brokaw. Pending Claim 1 that was rejected in the Office Action was discussed along with *Hokanson* and *Kohl*. In particular, the discussion focused on the features expressly recited in Claim 1 that are not disclosed, taught, or suggested by *Hokanson* and *Kohl*, either individually or in combination. An agreement was reached that Claim 1 would be allowable over *Hokanson* and *Kohl* if Claim 1 were amended to recite the feature that "execution of the database commands allows the second parties to manipulate data objects stored within at least one of the one or more database systems." The Applicant is providing herein the amendments and arguments proposed and presented during the interview.

## CLAIM 1 IS PATENTABLE OVER THE CITED ART

Even if *Hokanson* and *Kohl* were to be properly combined, Claim 1 would be patentable over *Hokanson* and *Kohl* as Claim 1 features subject matter that is not disclosed, taught, or suggested by *Hokanson* and *Kohl*, either individually or in combination.

Claim 1 features the elements of:

> "a first party managing one or more database systems;
> a plurality of second parties subscribing to database services supported by the one or more database systems managed by the first party, wherein the database services include services for storing and managing data provided by the second parties; and
> providing, over a network, to database applications controlled by the second parties, access to the database services to which the second parties are subscribed,
> wherein the database applications, controlled by the second parties, interact with the database systems managed by the first party by sending, to the database systems, database commands that conform to the database language supported by the database system, and
> wherein execution of the database commands allows the second parties to manipulate data objects stored within at least one of the one or more database systems." (emphasis added)

One or more of the above-quoted elements is not disclosed, taught, or suggested by *Hokanson* and *Kohl*, either individually or in combination.

There are many significant differences between the approach of Claim 1 and the approach of either *Hokanson* or *Kohl*. Claim 1 is directed towards provisioning databases for users on a wide area network. In the approach of Claim 1, a first party manages one or more database systems. **A plurality of second parties subscribe to database services** supported by the one or more database systems being managed by the first party. **The database services include services for storing and managing data provided by the second parties**. Database applications controlled by the second parties are provided access to the database services to which the second parties are subscribed. **The database application interact with the database systems** managed by the first party **by sending, to the database systems, database**

**commands** that conform to the database language supported by the database system. **When the database commands are executed by the first party, the second parties may manipulate data objects stored within at least one of the one or more database systems.** Significantly, such an approach allows the second parties to avoid the cost and frustration of managing and maintaining a database system, while still providing to the second parties the ability to store data in a database system managed by the first party, and to manipulate data objects stored within a database system managed by the first party.

Importantly, with respect to Claim 1, both *Hokanson* and *Kohl* teach very different approaches for achieving very different goals, as explained in detail below.

*Hokanson* does not suggest numerous elements of Claim 1

The goal of *Hokanson* is to improve the efficiency of retrieving resources that are located remotely over a network. To achieve this goal, *Hokanson* teaches defining a cost/availability balance for a local site. User requests for resources, originating at the local site, are monitored. Once the cost of supplying a resource located remotely to requestors at the local site exceeds the cost/availability balance, a copy of the resource is stored locally at the local site, thereby minimizing the cost in supplying the resource to future requestors of the resource which are located at the local site (See Abstract; FIG. 3).

*Hokanson* is cited (at Col. 8, line 62 to Col. 9, line 32; Col. 4, line 47 to Col. 5, line 34; Col. 2, lines 34-67; Col. 10, line 36 to Col. 11, line 53) by the Office Action to show the element of "a plurality of second parties subscribing to database services supported by the one or more database systems managed by the first party, wherein the database services include services for storing and managing data provided by the second parties." The entire disclosure of *Hokanson* lacks any suggestion of any party subscribing to database services supported by

database systems being managed by another party. While the cited portion of *Hokanson* teaches a party requesting a resource from another party, this act does not meet the express limitations of Claim 1 because, *inter alia*, requesting a resource does not in any way suggest subscribing to database services supported by a database system managed by another party. Further, Claim 1 requires that the database services to which the second parties are subscribed include services for storing and managing data provided by the second parties. No portion of *Hokanson* suggests a first party providing services to a set of second parties to allow the set of second parties to store and manage data, provided by the second parties, using database systems managed by the first party. Consequently, *Hokanson* cannot disclose, teach, or suggest this element.

Additionally, no portion of *Hokanson* suggests the element of "wherein execution of the database commands allows the second parties to manipulate data objects stored within at least one of the one or more database systems." Consequently, *Hokanson* cannot disclose, teach, or suggest this element as well.

*Kohl* does not suggest numerous elements of Claim 1

The approach of *Kohl* is also very dissimilar to the approach of Claim 1. The goal of *Kohl* is to design an application using a web browser. To achieve this goal, *Kohl* teaches using a web browser to interact with an interpretive server. A user may use the web browser to instruct the interpretive server to modify and store application definition data in a DBMS. The application definition data defines the visual characteristics and behavior of an application. In this way, a user may use a "simple point-and-click interface that requires no programming experience" to change the visual and behavioral characteristics of an application (See Col. 4, line 45 to Col. 9, line 15).

*Kohl* is cited (at Col. 8, lines 11-58) by the Office Action to show the element of "providing, over a network, to database applications controlled by the second parties, access to the database services to which the second parties are subscribed." However, the cited portion of *Kohl* only discusses the interpretive server having access to database services, in particular, to store application definition data in DBMS 210. To meet the requirements of Claim 1, access to the database services to which the second parties are subscribed must be provided to a database application controlled by the second parties. However, the entire disclosure of *Kohl* lacks the concept of (a) database applications controlled by any party other than the party managing a database system, (b) a second party subscribing to database services supported by one or more database systems managed by a first party, and (c) providing access to database services to which a second party is subscribed. For example, the party associated with web browser 200 in FIG. 3A (a) does not subscribe to database services supported by one or more database systems managed by another party, and (b) is not associated with any database applications that have access to the database services supported by DBMS 210. Consequently, this element cannot possibly be disclosed, taught, or suggested by *Kohl*.

Further, *Kohl* is cited (at Col. 8, lines 11-58) by the Office Action to show the element of "wherein the database applications, controlled by the second parties, interact with the database systems managed by the first party by sending, to the database systems, database commands that conform to the database language supported by the database system." As explained above, no portion of *Kohl* even suggests anything that could be construed analogous to "a plurality of second parties subscribing to database services supported by the one or more database systems managed by the first party."

Moreover, this element requires that the database applications, controlled by the second parties, interact with the database systems managed by the first party by sending, to the database

systems, database commands that conform to the database language supported by the database system. Only the interpretive server 315 of FIG. 3A sends database commands to a database system, namely DNMS 210. However, the interpretive server 315 cannot possibly be analogous to a database application, controlled by a second party, that interacts with a database system managed by the first party, since both the interpretive server 315 and the DBMS 210 are managed by the same party in the approach of *Kohl*. Further, the disclosure of *Kohl* makes clear that web browser 200 does not send database commands to DBMS 210, but instead, communicates with the interpretive server 310 via the web sever 205. Consequently, this element cannot possibly be disclosed, taught, or suggested by *Kohl*.

Additionally, no portion of *Kohl* suggests the element of "wherein execution of the database commands allows the second parties to manipulate data objects stored within at least one of the one or more database systems." Consequently, *Kohl* cannot disclose, teach, or suggest this element as well.

Even if properly combined, *Hokanson* and *Kohl* do not suggest numerous elements of Claim 1

As explained above, even if *Hokanson* and *Kohl* were to be properly combined, the resulting combination would still not result in the express combination of elements featured in Claim 1. Consequently, it is respectfully submitted that Claim 1 is patentable over the cited art and is in condition for allowance.

## *HOKANSON* AND *KOHL* HAVE NOT BEEN PROPERLY COMBINED

The Office Action states that:

> It would have been obvious to one of ordinary skill in the art at the time of the invention to modify the teachings of *Hokanson* with the teachings of *Kohl* to include "providing, over a network, to database applications controlled by the second parties, access to the database services to which the second parties are subscribed; wherein the database applications, controlled by the second parties, interact with the database systems managed by the first party by sending, to the database systems, database commands that conform to the database language supported by the database system" in order to provide a method for designing, generating and storing applications that enables users to retrieve and manipulate data over a client-server connection in an extremely flexible manner.

However, notwithstanding the fact that neither *Hokanson* nor *Kohl* disclose numerous claim elements as explained above, the Applicants respectfully submit that there is nothing in either *Hokanson* or *Kohl* that teaches or suggests combining their respective teachings.

As stated in the Federal Circuit decision *In re Dembiczak*, 50 USPQ.2d 1617 (Fed. Cir. 1999), (citing *Gore v. Garlock*, 220 USPQ 303, 313 (Fed. Cir. 1983)), "it is very easy to fall victim to the insidious effect of the hindsight syndrome where that which only the inventor taught is used against its teacher." *Id.* The Federal Circuit stated in *Dembiczak* "that the best defense against subtle but powerful attraction of a hindsight-based obviousness analysis is rigorous application of the requirement for a showing of the teaching or suggestion to combine prior art references." *Id.* Thus, the Federal Circuit explains that a proper obviousness analysis requires "***particular factual findings*** regarding the locus of the suggestion, teaching, or motivation to combine prior art references." *Id.* (emphasis added).

In particular, the Federal Circuit states:

> "We have noted that evidence of a suggestion, teaching, or motivation to combine may flow from the prior art references themselves, the knowledge of one of ordinary skill in the art, or, in some cases, from the nature of the problem to be solved...although 'the suggestion more often comes from the teachings of the pertinent references'...The range of sources available, however, does ***not diminish the requirement for actual evidence***. That is,

> the ***showing must be clear and particular***...Broad conclusory statements regarding the teaching of multiple references, standing alone, are not 'evidence.'" *Id.* (emphasis added; internal citations omitted).

Neither *Hokanson* or *Kohl* show any suggestion, teaching, or motivation to combine their teachings, nor does the Office Action provide a "clear and particular" showing of the suggestion, teaching, or motivation to combine their teachings. In fact, the only motivation provided in the Office Action is the hindsight observation that by combining features of those references, one may achieve the benefits achieved from the invention as described and claimed in the application.

Further, given the fact the approach of *Hokanson* and the approach of *Kohl* are directed towards very different goals by taking very different approaches, it is entirely unclear, and left answered in the Office Action, how the approach of *Hokanson* can be used in combination with the approach of *Kohl*. For example, *Kohl* teaches an approach for designing an application using a web browser. However, the approach *Hokanson* has nothing to do with designing an application, so it is unclear how the approach of *Kohl* can be used with *Hokanson*, let alone augment the utility of *Hokanson*. *Hokanson* teaches an approach for improving the efficiency of retrieving resources that are located remotely over a network. However, in the approach of *Kohl*, all the resources are located in a fixed location (DBMS 210), so it is unclear how the approach of *Hokanson* can be used with *Kohl*, let alone augment the utility of *Kohl*.

It is respectfully submitted that such a hindsight observation is not consistent with the Federal Circuit's requirement for "particular factual findings."

## CLAIMS 2-70 ARE PATENTABLE OVER THE CITED ART

Independent Claim 36 recites features that are similar to those discussed above with respect to Claim 1, except that Claim 36 is recited in computer-readable medium format.

Consequently, for at least the reasons given above with respect to Claim 1, it is respectfully submitted that Claim 36 is also patentable over the cited art and is in condition for allowance.

Claims 2-35 and 37-70 are dependent claims, each of which depends (directly or indirectly) on one of the claims discussed above. Each of Claims 2-35 and 37-70 is therefore allowable for the reasons given above for the claim on which it depends. In addition, each of Claims 2-35 and 37-70 introduces one or more additional limitations that independently render it patentable. However, due to the fundamental differences already identified, to expedite the positive resolution of this case a separate discussion of those limitations is not included at this time, although the Applicants reserve the right to further point out the differences between the cited art and the novel features recited in the dependent claims.

## CONCLUSION

For the reasons set forth above, it is respectfully submitted that all of the pending claims are now in condition for allowance. Therefore, the issuance of a formal Notice of Allowance is believed next in order, and that action is most earnestly solicited.

The Examiner is respectfully requested to contact the undersigned by telephone if it is believed that such contact would further the examination of the present application.

To the extent necessary, a petition for an extension of time under 37 C.F.R. § 1.136 is hereby made. Please charge any fee shortages or credit any overages Deposit Account No. 50-1302.

Respectfully submitted,
HICKMAN PALERMO TRUONG & BECKER LLP

Christopher J. Brokaw
Reg. No. 45,620

2055 Gateway Place, Suite 550
San Jose, California 95110-1089
(408) 414-1080 ext. 225
Date: **February 16, 2005**
Facsimile: (408) 414-1076

**CERTIFICATE OF MAILING**

I hereby certify that this correspondence is being deposited with the United States Postal Service as first class mail in an envelope addressed to: Mail Stop Amendment, Commissioner for Patents, P. O. Box 1450, Alexandria, VA 22313-1450

on February 16, 2005 by Angelica Maloney
Angelica Maloney